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ATTORNEY DOCKET NUMBER: 2003080-0071 (SK-744-CON4)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Danishefsy, *et al.* Examiner:
Serial No.: 10/004,571 Art Unit: 1626
Filing Date: December 4, 2001
Title: Synthesis of Epothilones, Intermediates Thereto, Analogues and Uses
Thereof

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, DC 20231

Sir:

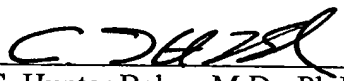
TRANSMITTAL LETTER

Enclosed are the following documents:

1. Form PTO-1449 (5 pages);
2. Information Disclosure Statement (5 pages);
3. Return Postcard

If any additional fees are required to be paid or if any overpayment has been made, please charge same to Deposit Account No. 03-1721.

Respectfully submitted,


C. Hunter Baker, M.D., Ph.D.
Reg. No. 46,533

Choate, Hall & Stewart
Exchange Place
53 State Street
Boston, MA 02109
(617) 248-5000
Dated: 10/25/02

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October 25, 2002
for A. W. Baker



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ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, DC 20231

Sir:

STATEMENT FILED PURSUANT TO THE DUTY OF DISCLOSURE
UNDER 37 CFR §§1.56, 1.97 AND 1.98

Pursuant to the duty of disclosure under 37 C.F.R. §§1.56, 1.97 and 1.98, Applicants respectfully request consideration of this Information Disclosure Statement.

PART I: Compliance with 37 C.F.R. §1.97

(Select A, B or C below)

A. ☒ This Information Disclosure Statement has been filed:

(check 1, 2 and/or 3 below)

1. ☐ within three months of the filing date of the above identified U.S. Patent application;
2. ☐ within three months of the filing date of the entry of the National Stage, as set forth in 37 C.F.R. §1.491, in an International application; and/or
3. ☒ before the mailing date of the first Office Action on the merits in the above-identified application.

No fee or certification is required.

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- B. ☐ This Information Disclosure Statement has been filed more than three months after the filing date of the present application and after the mailing date of this first Office Action, but before the mailing date of either a final action under 37 C.F.R. §1.113 or a Notice of Allowance under 37 C.F.R. §1.311.

(check 1 or 2 below)

1. ☐ The fee of \$180 as set forth in 37 C.F.R. §1.17(p) is enclosed; or
2. ☐ Applicants hereby certify, as specified in 37 C.F.R. §1.97(e), that
(check a or b below)
 - a. ☐ each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign Patent Office in a counterpart for this application not more than three months prior to the filing of this Statement; or
 - b. ☐ no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign Patent Office in a counterpart for this application or, to the knowledge of the undersigned after making reasonable inquiry, was known to any individual designated in 37 C.F.R. §1.56(c) more than three months prior to the filing of this Statement.
 - c. ☐ items indicated by an asterisk were identified in a recent review of related files.

- C. ☐ This Information Disclosure Statement has been filed after the mailing date of either a Final action under 37 C.F.R. §1.113 or a Notice of Allowance under 37 C.F.R. §1.311 and before payment of an Issue Fee.

(check 1, 2, and 3 below)

1. ☐ The Applicant hereby certifies, as specified in 37 C.F.R. §1.97(e), that:
(check a or b below)
 - a. ☐ each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign Patent

Office in a counterpart for this application not more than three months prior to the filing of this Statement.

- b. ☐ no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign Patent Office in a counterpart for this application or, to the knowledge of the undersigned after making reasonable inquiry, was known to any individual designated in 37 C.F.R. §1.56(c) more than three months prior to the filing of this Statement.
2. ☐ A Petition requesting consideration of the Information Disclosure Statement is attached.
3. ☐ The Petition Fee of \$130 as set forth in 37 C.F.R. §1.17(i)(1) is enclosed.

PART II - Information Cited

- A. ☒ The Applicant hereby makes of record in the above-identified application the reference(s) listed on the attached form PTO-1449 (modified). The order of presentation of the references should not be construed as an indication of the importance of the references.
- B. ☐ The Applicant hereby makes the following additional information of record in the above-identified application:

PART III: Explanation of Non-English Language References and Remarks Concerning Other Information Cited

- A. ☐ The following is a concise explanation of the relevance of each non-English language reference listed on the attached form PTO-1449 (modified):
- B. ☐ The following are remarks concerning the other information cited:

PART IV: Remarks

- A. ☒ Copies of references
(check 1 or 2 below)
1. ☐ A copy of each of the references cited on the attached form PTO-1449 (modified) is enclosed;
 2. ☒ Copies of certain of the references cited on the attached form PTO-1449 (modified) are not enclosed because each of these references (indicated by asterisk) was previously cited by or submitted to the Office in prior application no. 10/062,376 filed February 1, 2002, which prior application is relied upon for an earlier filing date under 35 U.S.C. § 120.
- B. ☒ It is respectfully requested that:
(check 1, 2, and 3 below)
1. ☒ The Examiner consider completely the cited information, along with any other information, in reaching a determination concerning the patentability of the present claims;
 2. ☒ The enclosed form PTO-1449 be signed by the Examiner to evidence that the cited patent(s) and publication(s) has (have) been fully considered by the Patent and Trademark Office during the examination of this application;
 3. ☒ The citations for the patent(s) and publication(s) be printed on any patent which issues from this application.
- C. ☒ By submitting this Information Disclosure Statement, Applicants make no representation that a search has been performed, of the extent of any search performed, or that more material information may not exist.

- D. [X] By submitting this Information Disclosure Statement, Applicants make no representation that the information cited in the Statement is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56(b).
- E. [X] By submitting this Information Disclosure Statement, Applicants make no representation that the information cited in the Statement is, or is considered to be, in fact, prior art as defined by 35 U.S.C. §102.
- F. [X] Notwithstanding any statements by Applicants, the Examiner is urged to form his or her own conclusions regarding the relevance of the cited reference(s).

An early and favorable action is hereby requested.

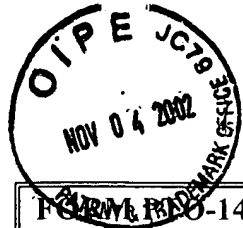
Please charge any additional fees or credit any overpayments to our Deposit Account No. 03-1721.

Respectfully submitted,

By: C. Hunter Baker
C. Hunter Baker, M.D., Ph.D.
Reg. No. 46,533

CHOATE, HALL & STEWART
Exchange Place
53 State Street
Boston, Massachusetts 02109
(617) 248-5000
Dated: 10/29/02
3471896

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on Oct 28, 2002
Eric A. Walker



FD-300 (REV. 8-83)

U.S. Department of
Commerce
Patent and Trademark OfficeATTY. DOCKET:
2003080-0071
(SK-744-CON4)IN RE
APPLICATION
NO.:
10/004,571

INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

APPLICANT: DANISHEFSKY, ET AL.

FILING DATE:
DECEMBER 4, 2001

GROUP: 1626

U.S. PATENT DOCUMENTS

Examiner's Initials	U.S. Patent No.	Applicant	Issue Date	Class	Subclass
	*6,262,094	Hoefle, et al.	July 17, 2001	514	365
	*6,291,684	Borzilleri, et al.	September 18, 2001	548	961
	*6,303,342	Julien	October 16, 2001	435	76
	*6,303,767	Betlach	October 16, 2001	536	23.2
	*6,320,045	Kim, et al.	November 20, 2001	540	463
	*6,350,878	Altmann	February 26, 2002	548	110
	*6,359,140	Hofle	March 19, 2002	548	204
	*6,365,749	Kim	April 2, 2002	548	204
	*6,369,234	Danishefsky	April 9, 2002	548	204
	*6,380,227	Mutz	April 30, 2002	514	365
	*6,380,394	Nicholaou	April 30, 2002	548	125
	*6,380,395	Vite	April 30, 2002	548	146
	*6,383,787	Schupp	May 7, 2002	435	183
	*6,384,230	Mulzer	May 7, 2002	548	203
	*6,387,927	Altmann	May 14, 2002	514	311
	*6,399,638	Vite	June 4, 2002	514	366
	*6,410,301	Julien	June 25, 2002	435	252.3

U.S. PATENT APPLICATIONS

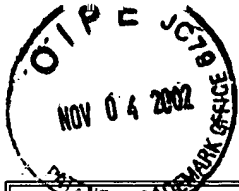
Examiner's Initials:	Serial Number:	Applicant:	Filing Date:	Group:	Art Unit:
	*20010031880	Borzilleri, et al.	October 18, 2001	548	961
	*09/686,158	Danishefsky, et al.	October 11, 2000		
	*10/004,571	Danishefsky, et al.	December 4, 2001		
	*2001/0031880	Borzilleri, et al.	April 16, 2001		
	*2001/0034452	Hoefle, et al.	December 4, 2001		
	*2001/0051356	Khosla	December 12, 2000		

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FORM PTO-1449

(REV. 8-83)

U.S. Department of
Commerce
Patent and Trademark OfficeATTY. DOCKET:
2003080-0071
(SK-744-CON4)IN RE
APPLICATION
NO.:
10/004,571**INFORMATION DISCLOSURE STATEMENT***(Use several sheets if necessary)*

APPLICANT: DANISHEFSKY, ET AL.

FILING DATE:
DECEMBER 4, 2001

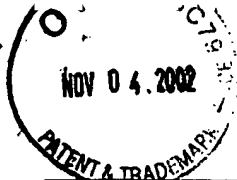
GROUP: 1626

	*2002/0002194	Danishefsky, et al.	June 5, 2001		
	*2002/0002162	Lee	March 26, 2001		
	*2002/0004229	Santi, et al.	May 1, 2001		
	*2002/0010328	Reeves et al.	April 3, 2001		
	*2002/0028839	O'Reilly et al.	August 9, 2001		
	*2002/0042109	Vite, et al.	March 19, 2001		
	*2002/0045220	Khosla, et al.	February 28, 2001		
	*2002/0045609	Ashley, et al.	May 15, 2001		
	*2002/0052028	Santi, et al.	August 9, 2001		
	*2002/0058286	Danishefsky, et al.	March 1, 2001		
	*2002/0058817	Danishefsky, et al.	March 1, 2002		
	*2002/0062030	White, et al.	April 30, 2001		
	*2002/0065295	Chu, et al.	May 10, 2001		
	*2002/0091269	Avery	October 15, 2001		

FOREIGN PATENT DOCUMENTS

Examiner's Initials	Document No.	Country	Date	Translation	
				Yes	No
	*WO 99/28324	WO	10 June 1999		
	*WO 99/278901	WO	10 June 1999		
	*WO 99/07692	WO	18 February 1999		
	*WO 99/03848	WO	28 January 1999		
	*WO 99/01124	WO	14 January 1999		
	*WO 98/38192	WO	3 September 1998		
	*WO 98/22461	WO	18 November 1997		
	*WO 93/10121	WO	27 May 1993		
	*WO 95/03035	WO	02 February 1995		

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FORM PTO-1449 (REV. 8-83)		U.S. Department of Commerce Patent and Trademark Office	ATTY. DOCKET: 2003080-0071 (SK-744-CON4)	IN RE APPLICATION NO.: 10/004,571
INFORMATION DISCLOSURE STATEMENT <i>(Use several sheets if necessary)</i>			APPLICANT: DANISHEFSKY, ET AL.	
			FILING DATE: DECEMBER 4, 2001	GROUP: 1626
Examiner's Initials	Citation (Including Author, Title, Date, Pertinent Pages, Etc.)			

*asterisk indicates submitted with application no.: 10/062,376, filed February 1, 2002.

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